

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): Wolfgang Fraas et al.  
Appl. No.: 09/806,594  
Conf. No.: 4492  
Filed: March 30, 2001  
Title: METHOD FOR CONNECTING EXCHANGES VIA A PACKET-ORIENTED  
COMMUNICATION NETWORK  
Art Unit: 2663  
Examiner: R. Chang  
Docket No.: 112740-177

Director of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

This request is submitted in response to the Final Office Action dated January 24, 2006. This request is filed contemporaneously with USPTO form PTO/SB/33, "Pre-Appeal Brief Request for Review" and form PTO/SB/31, "Notice of Appeal."

**Remarks** begin on page 2 of this paper.

### **REMARKS**

Claims 7 and 9-12 are pending in the present application. Claim 7 is the focus of this request.

Claims 7 and 9-12 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Westberg* (US Patent 6,041,054) in view of *Bernstein et al.* (US Patent 6,404,765). Applicants submit the rejection is improper and should be reversed by this board.

Specifically, the cited art, alone or in combination, does not disclose a method for connecting exchanges via a packet-oriented communication network, wherein data transmission involves Internet Protocol data packets subdivided into substructure elements, and the connecting exchanges are connected to the packet-oriented communication network via a respective conversion device, wherein the method includes “inserting, via the transmitting conversion device, the substructure elements into data packets unchanged; extracting, via a receiving conversion device associated with a receiving one of the connecting exchanges, the substructure elements from the received data packets; and forwarding, via the receiving conversion device, the extracted substructure elements to the receiving one of the connecting exchanges unchanged” as recited in claim 7.

The recited features in claim 7 correspond to a method for transparently transmitting data in the form of substructure elements through a packet-oriented communication network using IP data packets. For the purposes of example only, the recited configuration allows for the transmission of ATM cells over an IP network (see, e.g., page 3 of original specification, line 28 - page 2, line 18). In contrast, *Westberg* teaches the opposite, i.e., transmitting IP data packets through an ATM network (see Abstract). Similarly, *Bernstein* discloses a method to transport cell based DS-X traffic over a cell based ATM network (see Abstract).

The teachings in both references are materially different from the features recited in the present claims. It should be pointed out from the outset that it is well-known in the art that Asynchronous Transfer Mode (ATM) is a connection-oriented technology, in which a connection is established between two endpoints before the actual data exchange begins. Furthermore, ATM is a cell relay network protocol which encodes data traffic into small fixed-sized (53 byte; 48 bytes of data and 5 bytes of header information - see *Bernstein*, col. 2, lines 14-18) cells

instead of variable sized packets as in packet-switched networks, such as the Internet Protocol or Ethernet. Thus, both references teach away from the subject matter of claim 7.

Furthermore, the cited art fails to teach or suggest inserting, via the transmitting conversion device, substructure elements into data packets unchanged. The Office Action has apparently conceded that *Westberg* fails to teach this feature (Office Action page 3, second and fifth paragraphs). And *Bernstein* clearly teaches a DS-X to ATM conversion of substructure elements ( col. 6, lines 3-8). It is not understood how the Office Action interpreted this teaching as providing substructure elements into data packets unchanged.

Moreover, Applicant submits that there is no teaching, suggestion or motivation for one having ordinary skill in the art to combine *Westberg* with *Bernstein* in the manner suggested in the Office Action. The Patent Office has the initial burden of proving a *prima facie* case of obviousness. *In re Rijckaert*, 28 U.S.P.Q. 2d 1955, 1956 (Fed. Cir. 1993). In making this determination, the question is not whether the differences between the prior art and the claims themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 218 U.S.P.Q. 871 (Fed. Cir. 1983)(emphasis added). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).

Further, the Federal Circuit has held that it is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Moreover, the Federal Circuit has held that "obvious to try" is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). "An-

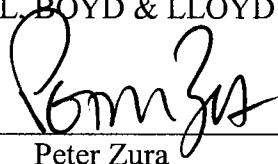
obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued.” *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

The disclosure in *Westberg* is directed to a mobile communication system where ATM adaption layer type two (AAL2) minicells are used for transferring IP packets, rather than ATM cells in accordance with AAL5 (col. 5, lines 28-31). *Westberg* clearly teaches that this method is used to enhance bandwidth for short-packet, low bit-rate data (col. 5, lines 31-42). In contrast, *Bernstein* teaches the use of DS-X transmission using virtual connections to establish high bit-rate data flow (col. 1, line 46 - col. 2, line 12), and further utilizes the DS-X format as an improvement over traditional ATM transmission (col. 2, lines 14-53; col. 3, lines 48-57). Also, there is no indication anywhere within the teaching of *Bernstein* that suggests that ATM communications are relegated only to the AAL2, as taught in *Westberg*.

In light of the above, Applicant respectfully submits that the rejection under 35 U.S.C. §103 is improper, and Claims 7 and 9-16 of the present application are both novel and non-obvious over the art of record. Accordingly, Applicant respectfully requests that the Board overturn the rejection and issue a timely Notice of Allowance in this case. If any additional fees are due in connection with this application as a whole, the Office is authorized to deduct said fees from Deposit Account No.: 02-1818. If such a deduction is made, please indicate the attorney docket number (0112740-177) on the account statement.

Respectfully submitted,  
BELL, BOYD & LLOYD LLC

BY



Peter Zura  
Reg. No. 48,196  
Customer No.: 24573  
Phone: (312) 807-4208

Dated: April 24, 2006